

E. REMARKS

This Reply is in response to the Office Action mailed on August 24, 2005 in which claims 1-10, 12-14 and 51-64 were rejected and claim 11 was objected to. With this Amendment, claim 1 is amended. Claims 1-14 and 51-64 are presented by the Applicants for reconsideration and allowance.

1. REJECTION OF CLAIMS 1-3, 5, 7, 9, 10 AND 51-64 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN

Section 2 of the Office Action rejected claims 1-3, 5, 7, 9, 10 and 51-64 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* (U.S. Patent No. 5,570,882) in view of *Martin* (U.S. Patent No. 4,570,931). Claim 1 is an independent claim and claims 2, 3, 4, 7, 9, 10 and 51-64 depend from claim 1. Independent claim 1 is currently amended to more clearly set forth the invention and is now believed to be patentably distinguishable over the cited prior art.

Independent claim 1, as amended, recites a football including a casing and an outwardly extending lacing. The lacing is coupled to the laced region of the casing. The lacing has an exposed surface. At least a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand. The football is configured for use in competitive play.

Applicants maintain their position, as discussed in the previous Amendment filed on June 10, 2005, that no suggestion to combine the references (*Horkan* and *Martin*) exists in either *Horkan* or *Martin*. Rather, the disclosures of *Horkan* and *Martin* would teach away from such a combination. Applicants also respectfully submit that neither *Horkan* nor *Martin*, alone or in combination, teach, suggest or disclose the combination of elements and limitations of independent claim 1, as amended. In particular, neither *Horkan* nor *Martin*, alone or in combination, teach, suggest or disclose a football configured for use in competitive play and including an outwardly extending lacing having a pebbled texture on at least a portion

of an exposed surface of the lacing, wherein the pebbled texture is highly grippable when directly contacted by a user's hand.

Horkan discloses a football training aid for young football players including a modified toy training football and a glove for use with the modified training football. *Horkan* is intended to assist young football players in properly grasping a football. *Horkan* states that younger football players with smaller hands usually have to cradle the ball in an incorrect palm-up fashion in order to attempt to pass the ball. *Horkan* seeks to prevent this incorrect grasping of the football by providing formed of Velcro® material and a glove having corresponding Velcro® material at the tips of the glove finger stalls. *Horkan* attempts to distinguish his disclosure from the prior art by limiting the use of the Velcro® material to only the lacing.

Horkan repeatedly emphasizes without deviation that the training football is to be grasped only at the laces and only with the use of the corresponding gloves. For example, *Horkan* includes the following statements:

“The football is grasped by a user wearing a glove having Velcro® hook elements only at the fingertips thereof.” Abstract, lines 2-3 (*emphasis added*).

“The restriction of the Velcro® elements to the football lacing and the fingertips of the glove urges the user to grasp the football only at the laces...” Abstract, line 4-6 (*emphasis added*).

“The invention relates to a training aid and, more particularly, to a modified football and glove combination...” Col. 1, lines 5-6 (*emphasis added*).

“The use of the Velcro® only on the laces forces the gloved user to properly grasp the football only at such laces.” Col. 1, lines 35-38 (*emphasis added*).

“The restriction of the Velcro® loop elements 120 to the lacing 110 of the football 100 is important.” Col. 2, lines 40-41 (*emphasis added*).

“Accordingly, the mating of the Velcro® elements 122 on glove 200 occurs only when the football 100 is properly grasped by a gloved 200 user at the laces 110 of football 100.” Col. 2, lines 43-46 (*emphasis added*).

“This restriction urges an initial proper FIG. 1 grasping of the football 100 by a gloved 200 user only at laces 110 as the gloved user cannot effectively grasp the football elsewhere.” Col. 2, lines 46-50 (*emphasis added*).

The disclosure and teaching of *Horkan* is clear. The Velcro® material is to be used only on the laces and the training football is to be used only with a gloved hand. *Horkan* uses the word “restriction” to describe these requirements of his invention. Moreover, *Horkan* emphasizes that his training football is not intended to be effectively grasped by the user at locations other than the lacing. *Horkan*’s training football has a very specific, restricted purpose. *Horkan* teaches away from the football as a whole being grippable to the user. *Horkan* also teaches away from the training football be grasped or directly contacted by the user’s hand.

Accordingly, *Horkan* alone, or in combination with *Martin*, does not teach, suggest or disclose the limitations of claim 1, as amended. *Horkan* discloses a training football configured only for use by gloved users and that cannot be effectively grasped by the gloved user at locations other than the lacing. The training football of *Horkan* is not configured for use in competitive play and is not configured for direct contact by the user’s hand, as required by claim 1, as amended. A football that is configured to be used only with gloves is not a football configured for competitive play. Moreover, a football that cannot be effectively grasped except at the laces is not a football that is suitable, or configured, for competitive play.

Further, *Horkan* does not teach, suggest or disclose a football having a lacing with an exposed surface that is highly grippable when directly contacted by a user’s hand. In fact, *Horkan* teaches away from the lacing being highly grippable to the user’s hand. *Horkan* absolutely requires that the lacing be formed of Velcro® material (preferably loop-type Velcro® material, but hook-type Velcro® material can also be used). Velcro® loop material or Velcro® hook material by itself (without use of the corresponding hook or loop material by

the gloved user) is much less grippable (more slippery) than the materials typically used to form the outer surface of footballs (natural leather and synthetic leather).

Applicants attach a copy of an Affidavit submitted in co-pending U.S. Patent Application Serial No. 10/325,421, also directed to footballs. The Affidavit includes a true and accurate copy of a test report entitled "Coefficient of Friction Testing of Various Materials" by Gaynes Labs Incorporated, an independent test laboratory, located at 9708 Industrial Drive, Bridgeview, Illinois 60455 ("Gaynes Labs"). The test report is the result of an effort to investigate the frictional characteristics of hook and loop materials (such as Velcro® loop material and Velcro® hook material). The assignee of the present invention, Wilson Sporting Goods Co. ("Wilson") contacted Velcro Group Incorporated, the producer of Velcro® brand hook and loop materials, requesting coefficient of friction information relating to Velcro® loop material and Velcro® hook material used separately a smooth surface when separated. On August 17, 2005, Velcro Group Incorporated provided test results showing static coefficient of friction values for Velcro® hook and loop specimens tested separately on a smooth surface in accordance with ASTM D1894. Because these test results were provided by Velcro Group Incorporated on a confidential basis, the results cannot be submitted to the Patent Office; however, as described below independent testing brought forth the same conclusion: hook or loop material on a game ball without the use of required gloves (having the corresponding or mating loop or hook material) results in a game ball that is not highly grippable and exhibits very low static coefficient of friction values.

Wilson then sought out an independent test laboratory (Gaynes Labs) in an effort to confirm this information and to compare the coefficient of friction test results for Velcro® hook and loop material with that of other materials, such as: a synthetic leather material, leather, and a representative smooth material, such as a plate of glass. The test report by Gaynes Labs was completed on October 10, 2005 and includes coefficient of friction testing results of the following materials: five pieces of a white single tone polyurethane ("PU") material used to form stripes on a football; five pieces of a brown dual-tone PU material used to form the cover panel

of a synthetic leather football; five pieces of genuine leather used to form a leather football; representative specimens of a Velcro® loop material; representative specimens of a Velcro® hook material; and a smooth plate of glass. Each material was testing in accordance with the American Society for Testing and Materials standard ASTM D1894-01 “Standard Test Method for Static and Kinetic Coefficients of Friction of Plastic Film and Sheeting” promulgated by ASTM International, 100 Barr Harbor Drive, PO Box C700, West Conshohocken, Pennsylvania, 19428.

The results of the test report illustrate that the average static coefficient of friction of five specimens of Velcro® hook material was 0.13, which is lower than the average static coefficient of friction of five specimens of Velcro® loop material measuring 0.18. This result is consistent with the static coefficient of friction information Wilson received from Velcro Group Corporation. The test report by Gaynes Labs also demonstrated that the coefficient of friction of genuine leather, synthetic leather (the brown dual-tone PU specimens) and the PU material used to form stripes (white single tone PU specimens) on a football all had average static coefficient of friction values that were much higher than the average static coefficient of friction values of either the Velcro® loop material specimens or the Velcro® hook material specimens.

The average static coefficient of friction values for the Velcro® hook and loop materials separately was comparable to the average static coefficient of friction values of a smooth plate of glass. The test results for the smooth plate of glass resulted in an average static coefficient of friction value of 0.16.

The genuine leather specimens had an average static coefficient of friction value of 0.39, which is over twice as high as the average static coefficient of friction values of the Velcro® loop material specimens or the Velcro® hook material specimens. The genuine leather specimens were the same leather that is used to produce the covers of leather footballs. It is important to note that the leather on leather footballs typically becomes more tactile over time as the leather is used and breaks in.

The PU test specimens used to form the outer cover of many game balls had average static coefficient of friction values of 3.48 and 4.02, respectively. Each of these values are significantly higher than the average static coefficient of friction values of either the Velcro® loop material specimens or the Velcro® hook material specimens.

Accordingly, Applicants respectfully submit that the test report of the attached affidavit demonstrates the hook or loop material used on the outer surface of a game ball, such as the lacing of *Horkan*, without the gloves required by *Horkan*, results in a football lacing that is not highly grippable when directly contacted by the hands of a user as required by claim 1, as amended.

Horkan includes no disclosure, teaching or suggesting indicating that it should be combined with *Martin*. Rather, *Horkan* teaches away from such a combination. *Horkan* discloses a training football that cannot be effectively grasped in locations other than the lacing. *Horkan* discloses the use of Velcro® material at the lacing of a football and corresponding Velcro® material on the glove of the user. The frictional interaction of Velcro® material when engaged with its corresponding Velcro® material (when the loop material engages the hook material) as taught by *Horkan* is greater than the frictional interaction of conventional game ball materials having pebbled textures.

Martin teaches incorporating a pebbled texture onto the outer surface of panels of a basketball, wherein the pebbled texture includes triangular shaped pebbles. *Martin* does not teach, suggest or disclose a football. *Martin* does not teach, suggest or disclose lacing for a football or any game ball. One of ordinary skill in the art would not seek to combine *Horkan* with *Martin* because any combination of the pebbled surface of *Martin* with the lacing of *Horkan* would result in a lacing having reduced frictional interaction than what is taught by *Horkan* alone.

Neither *Horkan* nor *Martin* teach, disclose or suggest the football of claim 1, as amended. Accordingly, it is respectfully submitted that amended claim 1 overcomes the

rejection based upon *Horkan* in view of *Martin*. It is also respectfully submitted that claims 2, 3, 5, 7, 9, 10 and 51-64, which depend from amended claim 1, are patentable over *Horkan*, and *Martin* for at least the same reasons.

2. *REJECTION OF CLAIMS 4, 8 AND 12 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FEENEY*

Section 3 of the Office Action rejected claims 4, 8, 11, 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Feeney* (U.S. Patent No. 6,283,881). Claims 4, 8, 11, 12 and 14 each depend from independent claim 1, as amended. Independent claim 1 is currently amended to more clearly set forth the invention and is now believed to be patentably distinguishable over the cited prior art. It is respectfully submitted that claims 4, 8, 11, 12 and 14 are patentable over *Horkan* in view of *Martin* and *Feeney* for at least the same reasons as discussed above relating to claim 1, as amended. *Feeney* discloses a basketball having a bladder, a carcass over the bladder and a plurality of panels coupled to an exterior surface of the carcass. The outer surface of the panels are formed with a plurality of raised projections. The projections are formed in loops with supplemental projections there within. *Feeney*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1, as amended. In particular, *Feeney* does not teach, suggest or disclose a football configured for use in competitive play and including an outwardly extending lacing having a pebbled texture on at least a portion of an exposed surface of the lacing, wherein the pebbled texture is highly grippable when directly contacted by a user's hand.

Horkan, *Martin* and *Feeney*, alone or in combination, do not teach, disclose or suggest the football of claim 1, as amended. Accordingly, it is respectfully submitted that claims 4, 8 and 12, which depend from amended claim 1, are patentable over *Horkan*, *Martin*, and *Feeney* for at least the same reasons.

3. *REJECTION OF CLAIM 6 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FINLEY*

Section 4 of the Office Action rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Finley* (U.S. Patent No. 4,991,842). Claim 6 depends from independent claim 1, as amended. Independent claim 1 is currently amended to more clearly set forth the invention and is now believed to be patentably distinguishable over the cited prior art. It is respectfully submitted that claim 6 is patentable over *Horkan* in view of *Martin* and *Finley* for at least the same reasons as discussed above relating to claim 1, as amended. *Finley* discloses a spherical basketball having a plurality of recesses formed on the exterior of the basketball and a network of interconnected ridges separating adjacent ridges. *Finley*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1, as amended. In particular, *Finley* does not teach, suggest or disclose a football configured for use in competitive play and including an outwardly extending lacing having a pebbled texture on at least a portion of an exposed surface of the lacing, wherein the pebbled texture is highly grippable when directly contacted by a user's hand.

Horkan, *Martin* and *Finley*, alone or in combination, do not teach, disclose or suggest the football of claim 1, as amended. Accordingly, it is respectfully submitted that claim 6, which depend from amended claim 1, is patentable over *Horkan*, *Martin*, and *Finley* for at least the same reasons.

**4. REJECTION OF CLAIMS 1-3 UNDER THE JUDICIALLY CREATED
DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3
OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO.
6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774**

Section 6 of the Office Action rejected claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774. In the Reply filed on June 10, 2005, Applicants submitted a separate executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent

No. 6,629,902, U.S. Patent No. 6,767,300, and U.S. Patent No. D457,208, along with the terminal disclaimer fee required under 37 CFR 1.20(d). A copy of these previously submitted terminal disclaimer forms is attached to this Reply. As noted in the present Office Action, a fourth terminal disclaimer incorrectly listed U.S. Patent No. D480,208 and not U.S. Patent No. D480,774. Accordingly, with this Reply, Applicants submit an executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. D480,774 to, in conjunction with the previously submitted terminal disclaimer forms, obviate the present double patenting rejection.

5. REJECTION OF CLAIMS 4, 8 AND 12 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO. 6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774 IN VIEW OF FEENEY

Section 7 of the Office Action rejected claims 4, 8 and 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774 in view of Feeney. In the Reply filed on June 10, 2005, Applicants submitted a separate executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, U.S. Patent No. 6,767,300, and U.S. Patent No. D457,208, along with the terminal disclaimer fee required under 37 CFR 1.20(d). A copy of these previously submitted terminal disclaimer forms is attached to this Reply. As noted in the present Office Action, a fourth terminal disclaimer incorrectly listed U.S. Patent No. D480,208 and not U.S. Patent No. D480,774. Accordingly, with this Reply, Applicants submit an executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. D480,774 to, in conjunction with the previously submitted terminal disclaimer forms, obviate the present double patenting rejection.

6. REJECTION OF CLAIMS 5, 7, 9, 10 AND 51-64 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO. 6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774 IN VIEW OF MARTIN

Section 8 of the Office Action rejected claims 5, 7, 9, 10 and 51-64 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774 in view of *Martin*. In the Reply filed on June 10, 2005, Applicants submitted a separate executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, U.S. Patent No. 6,767,300, and U.S. Patent No. D457,208, along with the terminal disclaimer fee required under 37 CFR 1.20(d). A copy of these previously submitted terminal disclaimer forms is attached to this Reply. As noted in the present Office Action, a fourth terminal disclaimer incorrectly listed U.S. Patent No. D480,208 and not U.S. Patent No. D480,774. Accordingly, with this Reply, Applicants submit an executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. D480,774 to, in conjunction with the previously submitted terminal disclaimer forms, obviate the present double patenting rejection.

7. REJECTION OF CLAIM 6 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIM 3 OF U.S. PATENT NO. 6,629,902, OR CLAIM 1 OF U.S. PATENT NO. 6,767,300, OR THE CLAIM OF D457,208, OR THE CLAIM OF D480,774 IN VIEW OF FEENEY

Section 9 of the Office Action rejected claim 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902, or claim 1 of U.S. Patent No. 6,767,300, or the claim of U.S. Patent No. D457,208, or the claim of U.S. Patent No. D480,774 in view of *Feeney*. In the Reply filed on June 10, 2005, Applicants submitted a separate executed USPTO Form PTO/SB/26,

entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, U.S. Patent No. 6,767,300, and U.S. Patent No. D457,208, along with the terminal disclaimer fee required under 37 CFR 1.20(d). A copy of these previously submitted terminal disclaimer forms is attached to this Reply. As noted in the present Office Action, a fourth terminal disclaimer incorrectly listed U.S. Patent No. D480,208 and not U.S. Patent No. D480,774. Accordingly, with this Reply, Applicants submit an executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. D480,774 to, in conjunction with the previously submitted terminal disclaimer forms, obviate the present double patenting rejection.

8. REJECTION OF CLAIMS 13 AND 14 UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER CLAIMS 3 AND 5 OF U.S. PATENT NO. 6,629,902 IN VIEW OF FEENEY

Section 10 of the Office Action rejected claims 13 and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 5 of U.S. Patent No. 6,629,902 in view of *Feeney*. In the Reply filed on June 10, 2005, Applicants submitted an executed USPTO Form PTO/SB/26, entitled "Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent," for U.S. Patent No. 6,629,902, along with the terminal disclaimer fee required under 37 CFR 1.20(d). A copy of this previously submitted terminal disclaimer forms is attached to this Amendment.

9. ALLOWABLE SUBJECT MATTER

Applicants appreciate the Examiner's statement in Section 12 of the Office Action that claim 11 is allowable.


10. CONCLUSION

Applicants respectfully request reconsideration of claims 1-10, 12-14 and 51-64. Applicants believe that the present application is now in condition for allowance. The

Examiner is invited to telephone the undersigned to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

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